

Docket No. F-8064

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REMARKS

Claims 1-5, 7, 8, 10, 11, and 13-26 are now pending in this application.

Claims 1-5, 7, 8, 10, and 11 are rejected. Claims 6, 9, and 12 are previously cancelled. New claims 13-26 are added. Claim 1 is amended herein to clarify the invention. Claims 2 and 10 are amended herein to be in better form. The specification has been amended and support for the amendment can be found at, for example, the specification as filed on page 4, second full paragraph, where it is stated that the adhesive "moves smoothly on the upper surface of the pattern by the surface tension of this adhesive 4." Support for the amendments of claim 1 and for the addition of new claims 13-26 can be found at, for example, the claims as filed, the substitute specification on page 5, first and second full paragraphs, page 7, first full paragraph, and Figures 2, 3, 5, 19, and 21.

The specification has been objected to under 35 U.S.C. § 132(a) for including new matter. The Office Action states that "the surface tension such that it will spread", as stated on p. 5, lines 8-10 of the substitute specification is not supported by the specification as filed. Applicants believe that one of ordinary skill in the art would read the specification, as filed, as disclosing that the adhesive spreads on the pattern due to surface tension. In any event, the language of "such that it will spread" has been replaced with "such that it will

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move smoothly," the support for which is mentioned above. Accordingly, Applicant respectfully requests that the objection to the specification be withdrawn.

Claims 1-5 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action states that there is no support in the specification for "the surface tension allows it to spread." As stated above, Applicant believes that such support does exist in the specification as filed. In any event, the language of claim 1 has been amended to recite that the adhesive has a surface tension such that the adhesive moves smoothly on the upper surface of the pattern. Accordingly, Applicant respectfully requests that the rejection of claims 1-5 under 35 U.S.C. § 112, first paragraph, be withdrawn.

The Office Action states that there is no support in the specification for an adhesive that is both soluble in water and alcohol. Applicant believes that the claims are appropriately written. In any event, claims 1 and 2 have been amended to refer to the adhesives which are soluble in water and in alcohol as alternatives. Claims 1-5 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Office Action states that the phrase "allows it to spread" is unclear as to whether it is a positive step or just a possible step and also that "it" is unclear as well.

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Claim 1 has been amended to address the definiteness issues raised in the Office Action and Applicant respectfully requests that the rejection of claims 1-5 under 35 U.S.C. § 112, second paragraph, as indefinite be withdrawn.

Claims 1, 2, 4, 5, 7, 8, 10, and 11 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,601,959 (Brault et al.). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131.

Claim 1 is patentable over Brault et al. at least for the reason that Brault et al. fails to disclose an adhesive having a surface tension such that the adhesive moves smoothly on the upper surface of the pattern, as recited in claim 1. The Office Action states that the adhesive in Brault et al. spreads over the surface and that it therefore must have the surface tension to allow it to spread. Applicant disagrees with this interpretation of Brault et al. but will not elaborate since claim 1 has been amended and no longer recites the word "spread." There is no disclosure in Brault et al. of an adhesive that moves smoothly because of the surface tension of the adhesive. Brault et al., on column 5, lines 43-48 states that the adhesive may be sprayed, coated with a roller, or laminated and there is no indication of smooth movement of the adhesive because of

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surface tension. Spraying, mechanical spreading by a roller, or lamination do not necessarily require smooth movement due to surface tension. Furthermore, Brault et al. fails to disclose the capability of transferring patterns such that they can overlay one another, as recited in claim 1. Accordingly, claim 1 is patentable over Brault et al. and notice to that effect is respectfully requested. Claims 2, 4, and 5 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974).

Claim 2 is further patentable over Brault et al. at least for the reason that Brault et al. fails to disclose an adhesive that can be colored by paint, as recited in claim 2.

Claims 7 and 10 are patentable over Brault et al. at least for the reason that Brault et al. fails to disclose the capability of transferring patterns such that they can overlay one another, as recited in claims 7 and 10. Claim 10 is further patentable over Brault et al. at least for the reason that Brault et al. fails to disclose an adhesive as being flexible and as having staining properties, as recited in claim 10. Claims 7 and 10 are therefore patentable over Brault et al. and notice to that effect is respectfully requested. Claims 8 and 11 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974).

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The arguments that Brault et al. fails to disclose the capability of transferring patterns such that they can overlay one another, fails to disclose an adhesive that can be colored by paint, and fails to disclose an adhesive as being flexible and as having staining properties were mentioned in the Amendment of March 10, 2005. The final Office Action of June 1, 2005 did not address those arguments and it is respectfully requested that those arguments be addressed.

Claim 3 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,110,317 (Brault et al.) and further in view of U.S. Patent No. 6,110,317 (Sandor). To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03. As admitted in the Office Action, Brault et al. fails to disclose applying a coating layer over the transferred image after the transfer step has been carried out and relies on Sandor for this teaching. The Federal Circuit has stated that the teaching of references can be combined *only* if there is some suggestion or incentive to do so. *See In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). Brault et al. can use the dielectric layer and the release layer as protection for the toned image. There is no indication that additional protection is needed and therefore the necessary incentive to combine Brault et al. and Sandor is missing. Furthermore, *prima facie* obviousness requires an

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expectation of success and there is no evidence that an additional protective layer in Brault et al. would succeed in achieving any of the objectives of Brault et al. Thus, *prima facie* obviousness is absent and claim 3 is patentable over the cited art.

Additionally, the clear finish layer disclosed in Sandor is a hard layer, as disclosed in column 10, lines 7-9 of Sandor. As described in column 5, lines 20-28 of Brault et al., the permanent receptor in Brault et al. is typically a web or sheet material which can be flexible and which can include textile fabrics. Using a hard layer on a flexible substrate would remove the flexibility of the substrate and the hard layer may even crack if the flexible substrate is bent. Thus, utilizing the clear finish layer disclosed in Sandor in the invention of Brault et al. would create problems with the invention of Brault et al. and therefore the references teach away from combining the clear finish layer disclosed in Sandor with the invention of Brault et al. Furthermore, claim 3 is patentable at least for the reason that it depends from a patentable base claim. See *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

New claims 13-26 have been added. Claim 13 is patentable over Brault et al. and Sandor at least for the reason that neither reference discloses or suggests applying the adhesive with a brush to the upper surface of the pattern, as recited in claim 13. Claims 14-26 are patentable at least for the reason that

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they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Six claims in excess of twenty are added. One independent claim in excess of three is added. The fee of 250.00 for the claims is provided for with the Request for Continued Examination (RCE) submitted concurrently herewith.

The response to the final Office Action of June 1, 2005 is being filed with a three month extension and the required fee accompanies the Request for Continued Examination (RCE) submitted concurrently herewith.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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